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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/485,071 02/03/00 REICH

N 30794.30USWO

022462 HM12/0719  
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EXAMINER

WILSON, J

ART UNIT

PAPER NUMBER

1623

DATE MAILED:

07/19/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trad marks**

# Office Action Summary

Application No.  
**09/485,071**

Applicant(s)

**Reich et al.**

Examiner

**James O. Wilson**

Group Art Unit

**1623**



☐ Responsive to communication(s) filed on \_\_\_\_\_

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 Month month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-25 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-25 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1623

## **DETAILED ACTION**

### ***Election/Restriction***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-10, drawn to a synthetic oligonucleotide comprising a C-5 methylcytosine, classified in class 536, subclass 23.1.
- II. Claims 11, 14 and 23-25, drawn to a method for inhibiting methylation of DNA, classified in class 435, subclass 15.
- III. Claims 12, 13, 15-17, 21 and 22, drawn to a method for treating cancer, classified in class 514, subclass 44+.
- IV. Claims 18-20, drawn to a method for identifying a molecule which recognizes and binds an allosteric site on DCMTase, classified in class 435, subclass 6.

The inventions are distinct, each from the other because of the following reasons:

Inventions of Group I and Groups II, III and IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the composition of matter as set forth in Group I may be used in the varied and materially different processes selected from Groups II, III and IV.

This application contains claims directed to the following patentably distinct methods of treating a patient, designated Groups II, III and IV cited supra.

These methods are seen to be patentably distinct methods for using the compositions of matter described in Group I. It is noted that each of these methods is recognized as divergent subject matter and each of the different methods is classified in a different art area. In fact, a reference rendering one of these methods obvious would not be used or expected to necessarily have applicability in establishing a prima facie case of obviousness over either of the other methods.

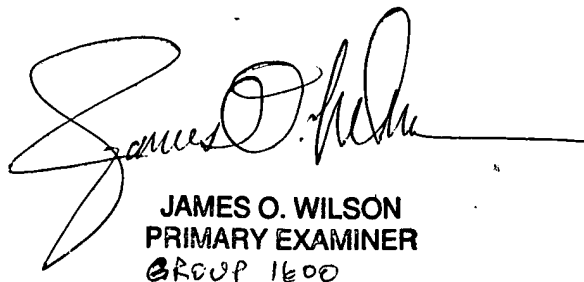
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Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Should applicant traverse on the ground that the methods are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the methods to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Because these inventions are distinct for the reasons given above and have acquired a separate and divergent status in the art as shown by their different classification, and because a search of the relevant subject matter for these diverse methods would indeed impose an undue burden upon the examiner in charge of this application, restriction for examination purposes as indicated is proper.

Any inquiry concerning this communication should be directed to James O. Wilson,  
Primary Examiner in Art Unit 1623 at telephone number (703) 308-4624.



**JAMES O. WILSON**  
**PRIMARY EXAMINER**  
GROUP 1600